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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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By: Linda L. Kaucher

(Signature of Person Mailing Paper or Fee)

In Re Application of

James Wright et al.

Serial No. 09/528,693

Filed: March 20, 2000

For: Method, System and Apparatus
for Providing Product
Information Over the Internet

Examiner: Andrew J. Fischer

Group Art Unit: 3627

Atty. Docket: 00P7518US

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Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action dated August 5, 2002, the period for response to which extends to November 5, 2002 by petition and fee, Applicants provisionally elect claims 1 to 6 with traverse.

The office action identifies three distinct inventions. Invention I, claims 1-6, are allegedly drawn to a product information apparatus, classified in class 700, subclass 234, invention II, claims 7-10, are allegedly drawn to a web page, classified in class 345, subclass 705, and claims 11-20, drawn to a method for providing product information, classified in class 705, subclass 27.

With respect to inventions I, II and III, Applicant disagrees that each independent claim is a distinct invention. Each claim set, an independent claim followed by corresponding dependent claims are each combinations, each specifying, in varying scope, a product information device.

The Office Action relies upon MPEP Section 806.05(c) to allege that inventions I and II, each independent claim and corresponding dependents claims covers a distinct invention. Applicant respectfully disagrees with the Office Action, in that, alleged invention I and II, claims 1 and 7 are combinations and are not a combination and subcombination. As defined in MPEP 806.05(a), a combination is an organization of which a subcombination or element is a part. Claim 7 is not a subcombination of claim 1, nor is claim 1 a subcombination of claim 7. The web page apparatus of claim 7 is an embodiment of the product information apparatus of claim 7, but is clearly not a part of said apparatus. Accordingly, Section 806.05(c) does not apply.

The Office Action also states that separate searches would be required for alleged invention 1 and alleged invention 2. Applicants respectfully disagree, and believe that a search for claim 1 will also apply to claim 7.

Paragraph 4 of said Office Actions indicated that inventions I and II are related as process and apparatus for its practice. It is the Examiners burden to show that the inventions are distinct, in that, either: 1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claims can be used to practice another and materially different process (MPEP Section 806.05(e)). The Examiner's show of proof was that "[I]n this case, the process can be practiced by

a materially different apparatus-one that does not require the indicator to be directed to the web page where the information is provided. Applicants respectfully traverse this rejection.

More specifically, claim 11 includes "connecting to a web page indicated by said indicator having said product information associated with said product information." As stated, this claim requires the indicator to be directed to the web page where the information is provided. Accordingly, MPEP Section 806.05(e) does not apply.

In paragraph 6 of the Office Action, alleged inventions II and III are alleged to be distinct. The Examiner states that "[I]n this case, the method can be practice by a materially different apparatus – one that does not require a help window." Applicants respectfully disagree. Inclusion or exclusion of a help window in claim 7 does not materially alter the apparatus that may practice the method of claim 7.

Claims 1, 7 and 11 do not recite distinct subcombinations. Instead, they are combinations of varying scope. Since claims 1, 7 and 11 include the same basic elements, and differ only in the specifics of some individual elements, Applicant disagrees that each independent claim set have acquired a separate status in the art and require different classification.

For the reasons provided above, Applicants respectfully submit that claims 1-20 should not be subject to a restriction requirement. Nevertheless, as required, Applicant provisionally elects claims 1-6.


An early favorable action on the merits is requested.

If a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned attorney at (732) 321-3113. If for any reason an insufficient fee has been paid, please charge the insufficiency to Deposit Account No.19-2179.

Date: November 4, 2002

Respectfully submitted,

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